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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,580	02/06/2002	Akihiko Fujii	Q68353	5449

23373 7590 01/15/2004
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EXAMINER

PICKETT, JOHN G

ART UNIT	PAPER NUMBER
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3728

6

DATE MAILED: 01/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/066,580

Applicant(s)

FUJII ET AL.

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office action acknowledges the applicant's Amendment A, presented as Paper No. 5. Claims 1, 3, 4, and 6 are pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Specification

3. The disclosure is objected to because of the following minor informalities: Page 2, line 4, "although excellent appearance in transparency" is grammatically incorrect.
Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. In light of the applicant's amendment, the rejection of claims 4-6 under 35 U.S.C. 112, first and second paragraphs, is hereby withdrawn.

Claim Rejections - 35 USC § 103

5. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morita (US 5,518,116) in view of Williams et al (US 5,720,916), Ewen et al (US 4,892,851), and Asanuma et al (EP 0 428 972 A2).

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Morita discloses a case (6) for a magnetic tape cassette (2). The case of Morita is made of a transparent resin (see for example, Col. 5, ll. 49-52). Morita does not expressly disclose the type of resin used or the components used in forming the resin.

Williams et al disclose that it is known in the art to use a resin material formed with a metallocene catalyst (see for example, Col. 1, ll. 55-63) to form articles. Williams et al teach the use of the resin material formed with a metallocene catalyst for the purpose of improved clarity of transparency and impact resistance (see for example, Col. 2, ll. 10-14). Ewen et al and Asanuma et al disclose how to make the material of Williams et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the case of Morita of a resin material formed with a metallocene catalyst, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Ewen et al disclose that changes in the amount of catalyst used effect the overall performance of the resulting resin (see for example, Tables 1, 2, and 4). The case of Morita-Williams-Ewen-Asanuma discloses the claimed invention except for the mass percentages claimed by the applicant. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the resin of Morita-Williams-Ewen-Asanuma using the mass percentages claimed by the applicant, since it has been held that where the general conditions of a claim are disclosed in the prior art,

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discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

6. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morita et al in view of Ewen et al and Asanuma et al as applied to claim 1 above, and further in view of Hanoka (US 6,114,046).

The case of Morita-Williams-Ewen-Asanuma discloses the claimed invention except for the use of a polyethylene material formed through the use of a metallocene catalyst.

Hanoka discloses a polyethylene material formed through the use of a metallocene used in an article (see for example, the Abstract). Hanoka teaches that the metallocene polyethylene is exceptionally clear with excellent physical properties (see for example, Col. 3, 7-11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the case of Morita-Williams-Ewen-Asanuma with a polyethylene material formed with a metallocene catalyst, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

As to claim 6, the case of Morita-Williams-Ewen-Asanuma-Hanoka discloses the claimed invention except for the mass percentages claimed by the applicant. It would have been obvious to one of ordinary skill in the art at the time the invention was made

to form the resin of Morita-Williams-Ewen-Asanuma using the mass percentages claimed by the applicant, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Response to Arguments

7. Applicant's arguments filed October 30, 2003 have been fully considered but they are not persuasive. Applicant's argument that Williams et al sets a lower limit of 40% is incorrect. As shown in Table 4, Williams anticipates mass percentages (as represented as SPP) ranging from 100% to 0% and therefore encompasses the range claimed by the applicant. Williams shows that haze is affected by mass percent of the mixture; according to Table 4, haze is a non-linear function of the mixture. Therefore mass percent is a results effective variable. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Thus, while Williams et al expresses a preference for the 85% mixture, at the same time it provides the motivation for one of ordinary skill in the art to focus on mass percentage of the mixture.

Applicants can rebut a prima facie case of obviousness based on overlapping ranges by showing the criticality of the claimed range. "The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. . . . In such a situation, the applicant must show that the

particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range.” In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). See MPEP § 716.02 - § 716.02(g) for a discussion of criticality and unexpected results.

The evidence relied upon should establish “that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance.” Ex parte Gelles, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992) (Mere conclusions in appellants’ brief that the claimed polymer had an unexpectedly increased impact strength “are not entitled to the weight of conclusions accompanying the evidence, either in the specification or in a declaration.”); Ex parte C, 27 USPQ2d 1492 (Bd. Pat. App. & Inter. 1992).

“[A]ppellants have the burden of explaining the data in any declaration they proffer as evidence of non-obviousness.” Ex parte Ishizaka, 24 USPQ2d 1621, 1624 (Bd. Pat. App. & Inter. 1992).

Applicant’s Exhibit A is inadmissible as it was not submitted with an oath or declaration as required under 37 CFR § 1.132. “The reason for requiring evidence in declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 25 and 18 U.S.C. 1001.” Permitting a publication to substitute for expert testimony would circumvent the guarantees built into the statute. Ex parte Gray, 10 USPQ2d 1922, 1928 (Bd. Pat. App. & Inter. 1989).

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Further, the exhibit fails to provide sufficient background data to indicate the criticality of the 25% point. The examiner questions whether the curve is, in fact, linear in the ranges presented.

In response to the applicant's arguments that the addition of Hanoka fails to teach or suggest the claimed mass percentages of the mixture, as discussed above, while Williams et al expresses a preference for the 85% mixture, at the same time it provides the motivation for one of ordinary skill in the art to focus on mass percentage of the mixture. As presented above, all elements set forth in the claims are disclosed or suggested in the prior art.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Gregory Pickett
Examiner
January 9, 2004


Mickey Yu
Supervisory Patent Examiner
Group 3700